

REMARKS

Applicants have canceled claims 1, 8, 12, and 13 without prejudice or disclaimer. Applicants have amended claims 2, 3, 5, 7, 9, and 10. The attached Appendix shows the changes to those claims. Applicants have added new claims 14 to 17. Support for the amendments and added claims are found throughout the specification and the originally filed claims. Claims 2 to 7, 9 to 11, and 14 to 17 are pending.

The Examiner objected to the oath or declaration. As permitted under 37 C.F.R. § 1.111(b), applicants respectfully request that this objection be held in abeyance until allowable subject matter is indicated.

The Examiner rejected claims 1 and 2 under 35 U.S.C. § 101 as allegedly encompassing naturally occurring material. Action at the paragraph bridging pages 2 and 3.

Solely in an effort to expedite prosecution, and not acquiescing to the rejection, applicants have added new claim 14, which recites "an isolated strain" as suggested by the Examiner. Thus, this rejection is moot.

The Examiner rejected claims 2, 9, 12, and 13 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Action at pages 3 and 4.

The Examiner suggested amending claim 2 to recite that the strain includes all of the identifying characteristics of the deposited strain. Solely in an effort to expedite prosecution, and not acquiescing to the rejection, applicants

have added amended 2 to recite "all of the identifying characteristics." Thus, this basis for the rejection is moot.

The Examiner contended that claim 9 includes improper Markush language. Applicants respectfully traverse. Solely to expedite prosecution, however, the language "the group consisting of" has been removed from the claim. The claim scope, however, has not been changed since one skilled in the art would understand that claim 9, before and after the amendment, encompasses washing with a buffer that comprises at least one of the listed materials. Thus, this basis for the rejection is moot.

The Examiner rejected claims 12 and 13 under both § 112, second paragraph, and § 101, since those claims were in the "use" format. Solely in an effort to expedite prosecution, and not acquiescing to the rejection, applicants have canceled claims 12 and 13 and replaced them with more traditional method claims 16 and 17. Thus, this basis for the rejection is moot.

The Examiner rejected claims 1 and 3 to 13 under 35 U.S.C. § 112, first paragraph, as allegedly not being enabled. Action at pages 4 to 7. The Examiner states that the specification only enables claims directed to the deposited *E. coli* strain or *E. coli* strains that are P1 transductions from that deposited strain. Action at page 6. The Examiner states that the specification fails to particularly identify the region or regions (called the *Hte* mutation) which is transferred by P1 transduction. Action at page 5. The Examiner contends that without knowledge of such region, "it would be impossible for the skilled artisan

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to make and use the invention as claimed without access to the specific P1 lysate described [in the specification].” Action at page 6. The Examiner also alleges that the invention should be limited to *E. coli*, since allegedly it is unclear whether the mutation would work in other gram negative bacteria. Action at page 6. Applicants respectfully traverse this rejection.

Claim 14 is directed to an isolated strain of *E. coli*, comprising an *Hte* mutation included in the strain deposited as ATCC No. 55962 and having more efficient transformation with foreign plasmids than *E. coli* that lack such an *Hte* mutation. Claim 2 is directed to a method that includes transferring a polynucleotide encoding an *Hte* mutation included in the strain deposited as ATCC No. 55962 into gram negative bacterial cells. Thus, both of claims 2 and 14 define the *Hte* mutation as being one that is included in a particularly deposited strain of *E. coli*. Applicants assert that one skilled in the art, in view of the present specification, would not require undue experimentation to make and use the claimed products and processes in view of the deposited strain.

With respect to methods and cells that are not limited to *E. coli*, the Examiner has not established why undue experimentation would be required to make and test such other host cells. The Examiner only states that it is unclear whether the mutation would work in other gram negative bacteria. The Examiner, however, provides no support for an assertion that undue experimentation would be required to determine hosts in which the mutation would work. Applicants assert that the making and testing of such cells would not encompass undue experimentation. Thus, if the rejection is maintained,

applicants respectfully request that the Examiner provide scientific basis for a conclusion that undue experimentation would be required.

Applicants respectfully request reconsideration and withdrawal of the § 112, first paragraph, rejection set forth at pages 4 to 7 of the Action.

The Examiner rejected claims 1 to 13 under 35 U.S.C. § 112, first paragraph, as allegedly not being enabled. Action at pages 7 to 8. The Examiner states that the applicants must provide a statement concerning the availability of the deposit.

Applicants assure the USPTO that an appropriate statement will be filed on or before the date of payment of the issue fee for this case. Under 37 C.F.R. § 1.809(b), an applicant is permitted to respond to a requirement for a deposit by making such an assurance. Thus, the undersigned understands that a similar assurance is acceptable for the purpose of responding to a requirement of an availability statement after a deposit has already been filed.

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Please grant any extension of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON,
FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 30, 2001

By: M. Paul Barker
M. Paul Barker
Reg. No. 32,013

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APPENDIX

2. (Amended) A strain according to claim [1] 14 that has been derived from a strain having all of the identifying characteristics of ATCC 55962.

3. (Amended) A method of preparing gram negative bacteria of improved competence, said method comprising [the steps of]:

a) transferring a polynucleotide encoding an [Hte^- region] Hte mutation included in the strain deposited as ATCC No. 55962 into gram negative bacterial cells; and

b) treating the cells from (a) with a competency inducing procedure; whereby competent cells are produced.

5. (Amended) A method according to claim 3, wherein the competency inducing procedure [is a standard high competency induction procedure employing the step of] comprises washing the cells with a buffer comprising at least two of [the group consisting of] potassium acetate, KCl, $MnCl_2$, $CaCl_2$, glycerol, rubidium chloride, and hexamine cobalt chloride.

7. (Amended) A method according to claim 3, said method further comprising [the step of] freezing the competent cells.

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9. (Amended) [Competent cells] A strain according to claim [8] 14, wherein [said] cells of said strain have been made competent by [the] a [standard] high competency induction procedure [employing the step of] comprising washing the cells with a buffer comprising at least one of [the group consisting of] potassium acetate, KCl, MnCl₂, CaCl₂, glycerol, rubidium chloride, and hexamine cobalt chloride.

10. (Amended) [Competent cells] A strain according to claim 9, wherein said cells of said strain have been frozen.

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